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26304	7590	06/15/2006	EXAMINER WILDER, PETER C	
KATTEN MUCHIN ROSENMAN LLP 575 MADISON AVENUE NEW YORK, NY 10022-2585			ART UNIT 2623	PAPER NUMBER

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/942,978	KUTARAGI ET AL.	
	Examiner	Art Unit	
	Peter C. Wilder	2623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Claims 1, 2, 4, 6, 7, 9, and 11 are amended.

Claims 3, 5, 8, 10, and 12 are original.

Response to Arguments

The applicant argues at the bottom of page 11 and on page 12 that the combination of the references or Hendricks et al. and Hofmann would not have taught claim 1.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

The examiner respectfully argues that the combination of Hendricks and Hoffman does teach the claimed invention of claim 1 as can be seen below.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 2623

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 1 rejected under 35 U.S.C. 103(a) as being unpatentable over Hendricks et al. (U.S. 6738978 B1) in view of Hofmann (U.S. 5883677).

Referring to claim 1, Hendricks teaches a method for managing fees of contents in which the fees arise based on a predetermined charging rule upon distributing the contents (Column 44 lines 49-58 teaches a set-top box utilizing movies on demand distributed from the head end and Column 47 lines 28-38 and Figure 31 teaches the ordering of a movie and that a price is associated with it), said method comprising the steps of:

equipping information gathering means on a network with which a user terminal is allowed to connect (Column 11 lines 46-65 teaches the head end gathering information from the set top box), said user terminal carrying out information processing by utilizing said contents (Column 12 lines 43-46 teaches the set top box has the ability to decode signals which is a form of information processing);

embedding to said contents (Column 27 lines 51-63 teaches a polling request sent from a head-end to a set-top box; Column 11 lines 14 - 19 teaches sending other digital signals to the set-top boxes over element 216 which also carries the pay per view movies and events in Figure 3 so the data is embedded together), digital information causing said user terminal to transmit a contents distributing history to said information

gathering means at a predetermined timing while said user terminal is connected with said network (Column 28 lines 18-27 teaches the set-top box returning digital information because of the polling request; Column 11 lines 61-62 teaches a predetermined time of daily, weekly, or monthly; Column 29 lines 6 - 39 teaches the list of programs watched sent from the set top box to the head-end)

distributing said contents with said digital information being embedded through a predetermined distribution mechanism (Column 11 lines 14-21 teaches digitally compressed signals which are the content signals and other digital signals which are the polling signals are sent down element 216 in Figure 3; Element 216 is a predetermined distribution mechanism);

counting a distribution condition of contents per distribution mechanism based on said contents distributing history gathered through said information gathering means and said identification information held by said identification information holding means (Column 41 lines 62-67 and Column 42 lines 1-7 teaches correlating each program with a price and from the last polling cycle and then having the CPU generate a bill; for a bill to be generated the CPU would need to count up the number to programs from the account history file); and

determining a charging amount per distribution mechanism based on said counted distribution condition and a charging rule for said contents (Column 42 lines 7-12 teaches assigning a charging amount or price to each program from last polling response and then generating a bill for each user based on the updated account history);

but fails to teach holding, by predetermined identification information holding means, identification information for identifying said distributed contents and said distribution mechanism.

In an analogous art Hofmann teaches holding, by predetermined identification information holding means, identification information for identifying said distributed contents and said distribution mechanism (Column 8 lines 43-46 teaches storing in database element 424 in Figure 4A information of the service provider (second line from bottom in Figure 6) and the distributed contents (First 3 lines in Figure 6)).

At the time of the invention it would have been obvious to a person of ordinary skill in the art to modify the video on demand system of Hendricks using the information holding device/function of Hofmann for the purpose of being able to search or classify each of the fields in a record (Column 8 lines 35-36 Hofmann).

Claims 2 and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maruo et al. (U.S. 6757909 B1) in view of Tsuria et al. (U.S. 6424947 B1) further in view of Hendricks et al. (U.S. 6738978 B1) still further in view of Russo (U.S. 5619247).

Referring to claim 2, Maruo teaches a method for managing fees of contents in which the fees arise based on a predetermined charging rule upon utilizing the contents (Column 4 lines 26-29 teaches the broadcast system receiving billing information from

subscribers for contents such as pay per view movies or events), said method comprising the steps of:

issuing a recording medium to a user operating a user terminal which carries out information processing by utilizing said contents (Column 8 lines 46-61 teaches the smart card having a key for descrambling broadcast signals from a system operator and the smart card being implemented by a user terminal element 450 in Figure 4; the smart card would have to be issued to the user or else no video could be watched);

equipping information gathering means on a network with which said user terminal with said recording medium being loaded is allowed to connect (Column 8 lines 47-54 teaches a smart card or recording medium being used; Column 7 lines 25-32 teaches the set-top box sends out billing information to a MSO so a connection exists between the user terminal or set-top box and the MSO),

but fails to teach said recording medium having a data recording area in which user identification data is recorded and a nonvolatile memory area; embedding digital information to said contents, said digital information causing said user terminal to store a contents utilizing history indicating utilizing condition of the contents to said memory area, and to read said stored contents utilizing history so as to transmit said contents utilizing history to said information gathering means along with said user identification data at a predetermined timing while said user terminal is connected with said network; counting a utilization condition of the contents per user based on the contents utilizing history and the user identification data gathered through said information gathering

Art Unit: 2623

means; and determining a charging amount per user based on said counted utilization condition and a charging rule for said contents.

In an analogous art Tsuria teaches said recording medium having a data recording area in which user identification data is recorded and a nonvolatile memory area (Column 6 lines 54-67 teaches the smart card, which is a recording medium, having personal identification number on it, and the card would have to have nonvolatile memory area on it because a smart card is a plastic card with no power source connected to it);

said user terminal to store a contents utilizing history indicating utilizing condition of the contents to said memory area, (Column 8 lines 49 – 56 teaches a smart card storing viewing habits which the examiner views as utilizing history; The examiner notes that the smart card 64 is different than smart card 42 which holds the user identification data, but notes in Column 12 lines 10-15 and Column 12 lines 21-28 teaches transferring parental control restriction codes which is user identification data between the two smart or information cards; Since this data is transferred one smart card element 64 contains both the user history and user identification information); but fails to teach digital information causing the said user terminal to store a contents utilizing history indicating utilizing condition of the contents and to read said stored contents utilizing history so as to transmit said contents utilizing history to said information gathering means along with said user identification data at a predetermined

timing while said user terminal is connected with said network and the rest of the limitations of claim 2.

At the time the invention was made it would have been clearly obvious for one skilled in the art to modify the data storing and retrieval method of Maruo using the storing of habits and preferences in a smart card function/device of Tsuria for the purpose of providing information to a broadcaster of the television transmissions (Column 8 lines 63-64 Tsuria).

Maruo and Tsuria fail to teach embedding to said contents, digital information causing said user terminal to store a contents utilizing history indicating utilizing condition of the contents to a memory area, to read said stored contents utilizing history so as to transmit said contents utilizing history to said information gathering means along with said user identification data at a predetermined timing while said user terminal is connected with said network; counting a utilization condition of the contents per user based on the contents utilizing history and the user identification data gathered through said information gathering means; and determining a charging amount per user based on said counted utilization condition and a charging rule for said contents.

In an analogous art Hendricks teaches embedding to said contents (Column 19 lines 26-31 teaches program control information or digital information being sent to the set top box), digital information causing said user terminal to store a contents utilizing history indicating utilizing condition of the contents to a memory area (Column 44 lines 55-58 teaches supporting movies on demand, Column 21 lines 22-25 teaches the

program control information containing pricing information so the set top box would know from the price information to store the data if the program with a price is utilized; Column 27 lines 50-54 teaches storing program access information which is the same as utilization history),

to read said stored contents utilizing history so as to transmit said contents utilizing history to said information gathering means along with said user identification data at a predetermined timing while said user terminal is connected with said network (Column 28 lines 18-27 teaches the set-top box returning digital information because of a polling request which is program control information, so the data has to be read from memory; Column 11 lines 61-62 teaches a predetermined time of daily, weekly, or monthly; Column 29 lines 6 - 39 teaches the list of programs watched sent from the set top box to the head-end);

distributing said contents with said digital information being embedded through a predetermined distribution mechanism (Column 11 lines 14-21 teaches digitally compressed signals which are the content signals and other digital signals which are the polling signals are sent down element 216 in Figure 3; Element 216 is a predetermined distribution mechanism); but fails to teach the rest of the limitations of claim 2.

At the time the invention was made it would have been clearly obvious for one skilled in the art to modify the combined methods of Maruo and Tsuria using the embedded program control digital information function/device of Hendricks for the

purpose of providing the set-top terminal 220 with billing information (Column 42 lines 15-16, Hendricks).

Maruo, Tsuria, and Hendricks fail to teach counting a utilization condition of the contents per user based on the contents utilizing history and the user identification data gathered through said information gathering means, and determining a charging amount per user based on said counted utilization condition and a charging rule for said contents.

In an analogous art Russo teaches counting a utilization condition of the contents per user based on the contents utilizing history and the user identification data gathered through said information gathering means (Column 5 lines 41-47 teaches counting the number of times the user utilizes the program if they store the program for an extend period of time, Column 10 lines 22-30 teaches the program provider being informed that a program has been viewed, and Column 9 lines 12-16 teaches a telephone line being used to communicate to the program provider billing and account transactions so identification information related to the user would have to be sent with the utilizing history or the program provider would not know who to bill, Column 67 lines 26-27 teaches a two way communication system between the user's system and the program provider); and determining a charging amount per user based on said counted utilization condition and a charging rule for said contents (Column 5 lines 41-47 teaches counting the number of times the user utilize the program if they store the program for an extend period of time and use view the program over an extend period of time).

At the time of the invention it would have been obvious to a person of ordinary skill in the art, to modify the combined methods of Maruo, Tsuria, and Hendricks using the utilization condition function/device of Russo for the purpose of having the user only responsible for payment only after a particular selection has been viewed or enjoyed (Column 1 lines 7-9, Russo).

Referring to claim 3, depending on claim 2, Maruo teaches a method for managing fees of contents according to claim 2, further comprising the steps of encrypting the contents to be distributed (Column 6 lines 40-49 teaches transmitting scrambled broadcast digital signals) and issuing key information for decrypting said encrypted contents, said key information being recorded in said recording medium (Column 8 lines 51-54 teaches a smart card having a key to descramble the digital broadcast signals).

Claim 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maruo et al. (U.S. 6757909 B1) in view of Tsuria et al. (U.S. 6424947 B1) further in view of Hendricks et al. (U.S. 6738978 B1) still further in view of Hofmann (U.S. 5883677) still further in view of Russo (U.S. 5619247).

Referring to claim 4, Maruo teaches a method for managing fees of contents in which the fees arise based on a predetermined charging rule upon distributing and utilizing the contents (see rejection of claim 1), said method comprising the steps of:

issuing a recording medium to a user operating a user terminal which carries out information processing by utilizing the distributed contents (Column 8 lines 46-61 teaches the smart card having a key for descrambling broadcast signals from a system operator and the smart card being implemented by a user terminal element 450 in Figure 4; the smart card would have to be issued to the user or else no video could be watched);

equipping information gathering means on a network with which said user terminal with said recording medium being loaded is allowed to connect (Column 7 lines 4-13 teaches the embodiments of a set top box, Column 7 lines 35-41 teaches element 570 as a network connection),

but fails to teach said recording medium having a data recording area in which user identification data is recorded and a nonvolatile memory area; embedding digital information to said contents, said digital information causing said user terminal to store monitoring information indicating a distribution history of the contents and a utilizing condition of the contents into said memory area, distributing said contents with said digital information being embedded through a predetermined distribution mechanism; holding, by predetermined identification information holding means, identification information for identifying said distributed contents and said distribution mechanism; counting a distribution condition of the contents per distribution mechanism and a utilizing condition of the contents per user based on said monitoring information and said user identification data gathered through said information gathering means and said identification information held by said identification information holding means; and

determining a charging amount per distribution mechanism based on said counted distribution condition and a charging rule for said contents, and determining a charging amount per user based on said counted utilization condition and a charging rule for said contents.

In an analogous art Tsuria teaches said recording medium having a data recording area in which user identification data is recorded and a nonvolatile memory area (Column 6 lines 54-67 teaches the smart card, which is a recording medium, having personal identification number on it, and the card would have to have nonvolatile memory area on it because a smart card is a plastic card with no power source connected to it), said user terminal to store a contents utilizing history indicating utilizing condition of the contents to said memory area, (Column 8 lines 49 – 56 teaches a smart card storing viewing habits which the examiner views as utilizing history; The examiner notes that the smart card 64 is different than smart card 42 which holds the user identification data, but notes Column 12 lines 10-15 and Column 12 lines 21-28 teach transferring parental control restriction codes which is user identification data between the two smart or information cards; Since this data is transferred one smart card element 64 contains both the user history and user identification information).

At the time of the invention it would have been obvious to a person of ordinary skill in the art, to modify the information gathering and processing function/device of Maruo using the storing of habits and preferences in a smart card function

function/device of Tsuria for the purpose of providing the information to a broadcaster of the television transmissions (Column 8 lines 63-64 Tsuria).

Maruo and Tsuria fail to teach embedding to said contents, and to read said stored contents utilizing history so as to transmit said contents utilizing history to said information gathering means along with said user identification data at a predetermined timing while said user terminal is connected with said network; distributing said contents with said digital information being embedded through a predetermined distribution mechanism, counting a distribution condition of the contents per distribution mechanism of the contents per user based on said monitoring information and said user identification data gathered through said information gathering means and said identification information held by said identification information holding means, and determining a charging amount per distribution mechanism based on said counted distribution condition and a charging rule for said contents.

In an analogous art Hendricks teaches embedding to said contents (Column 19 lines 26-31 teaches program control information or digital information being sent to the set top box); digital information causing said user terminal to store a contents utilizing history indicating utilizing condition of the contents to a memory area (Column 44 lines 55-58 teaches supporting movies on demand, so the embedded digital information in this case the movie received by the user terminal or set-top box stores the fact that a movie was receive in the utilizing history in memory; Column 27 lines 50-54 teaches

storing program access information which is the same as utilization history), and to read said stored contents utilizing history so as to transmit said contents utilizing history to said information gathering means along with said user identification data at a predetermined timing while said user terminal is connected with said network (Column 28 lines 18-27 teaches the set-top box returning digital information because of a polling request which is program control information, so the data has to be read from memory; Column 11 lines 61-62 teaches a predetermined time of daily, weekly, or monthly; Column 29 lines 6 - 39 teaches the list of programs watched sent from the set top box to the head-end);

distributing said contents with said digital information being embedded through a predetermined distribution mechanism (Column 11 lines 14-21 teaches digitally compressed signals which are the content signals and other digital signals which are the polling signals are sent down element 216 in Figure 3; Element 216 is a predetermined distribution mechanism), counting a distribution condition of the contents per distribution mechanism of the contents per user based on said monitoring information and said user identification data gathered through said information gathering means and said identification information held by said identification information holding means (Column 41 lines 62-67 and Column 42 lines 1-7 teaches correlating each program with a price and from the last polling cycle and then having the CPU generate a bill; for a bill to be generated the CPU would need to count up the number to programs from the account history file of the user);

and determining a charging amount per distribution mechanism based on said counted distribution condition and a charging rule for said contents (Column 42 lines 7-12 teaches assigning a charging amount or price to each program from last polling response and then generating a bill for each user based on the updated account history).

At the time of the invention it would have been obvious to a person of ordinary skill in the art, to modify the combined methods of Maruo and Tsuria using the embedded program control digital information and determining charging amount function/device of Hendricks for the purpose of providing the set-top terminal 220 with billing information (Column 42 lines 15-16, Hendricks), so the user does not require a bill to be sent in the mail.

Maruo, Tsuria, and Hendricks fail to teach holding, by predetermined identification information holding means, identification information for identifying said distributed contents and said distribution mechanism; counting a distribution condition of the contents per a utilizing condition of the contents; and determining a charging amount per user based on said counted utilization condition and a charging rule for said contents.

In an analogous art Hofmann teaches holding, by predetermined identification information holding means, identification information for identifying said distributed contents and said distribution mechanism (Column 8 lines 43-46 teaches storing in

database element 424 in Figure 4A information of the service provider (second line from bottom in Figure 6) and the distributed contents (First 3 lines in Figure 6)).

At the time of the invention it would have been obvious to a person of ordinary skill in the art, to modify combined methods of Maruo, Tsuria, and Hendricks using the identification holding function/device of Hofmann for the purpose of being able to search or classify each of the fields in a record (Column 8 lines 35-36 Hofmann), but fails to teach the rest of the limitations of claim 4.

Maruo, Tsuria, Hendricks, and Hofmann fail to teach counting a distribution condition of the contents per a utilizing condition of the contents, and determining a charging amount per user based on said counted utilization condition and a charging rule for said contents.

In an analogous art Russo teaches counting a distribution condition of the contents per a utilizing condition of the contents (Column 5 lines 41-47 teaches counting the number of times the user utilize the program if they store the program for an extend period of time and use view the program over an extend period of time);

and determining a charging amount per user based on said counted utilization condition and a charging rule for said contents (Column 5 lines 41-47 teaches charging the user based on the number of times they view the program if they store the program for an extend period of time).

At the time of the invention it would have been obvious to a person of ordinary skill in the art, to modify the combined methods of Maruo, Tsuria, Hendricks, and

Hofmann using the utilization history function/device of Russo for the purpose of having the user only responsible for payment only after a particular selection has been viewed or enjoyed (Column 1 lines 7-9, Russo).

Referring to claim 5, depending on claim 4, see rejection of claim 3

Claim 6, 9, and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maruo et al. (U.S. 6757909 B1) in view of Hendricks et al. (U.S. 6738978 B1) further in view of Hofmann (U.S. 5883677).

Referring to claim 6, Maruo teaches a system for managing fees of contents in which the fees arise based on a predetermined charging rule upon distributing the contents, said system comprising:

information gathering means provided on a network with which a user terminal is allowed to connect (Column 7 lines 4-13 teaches the embodiments of a set top box, Column 7 lines 35-41 teaches element 570 as a network connection), said user terminal carrying out information processing by utilizing said contents (Column 9 lines 7-9 teaches a decryption engine which processes the signal element 570);

but fails to teach distributing means for embedding to said contents, digital information causing said user terminal to transmit a contents distributing history to said information gathering means at a predetermined timing while said user terminal is connected with said network, and for distributing said contents with said digital

information being embedded through a predetermined distribution mechanism; counting means for counting a distribution condition of contents per distribution mechanism based on said contents distributing history gathered through said information gathering means and said identification information held by said identification information holding means, and fee calculating means for determining a charging amount per distribution mechanism based on said counted distribution condition and a charging rule for said contents; identification information holding means for holding identification information for identifying said distributed contents and said distribution mechanism.

In an analogous art Hendricks teaches distributing means for embedding to said contents (Column 27 lines 51-63 teaches a polling request sent from a head-end to a set-top box; Column 11 lines 14 - 19 teaches sending other digital signals to the set-top boxes over element 216 which also carries the pay per view movies and events in Figure 3 so the data is embedded together), digital information causing said user terminal to transmit a contents distributing history to said information gathering means at a predetermined timing while said user terminal is connected with said network (Column 28 lines 18-27 teaches the set-top box returning digital information because of the polling request; Column 11 lines 61-62 teaches a predetermined time of daily, weekly, or monthly; Column 29 lines 6 - 39 teaches the list of programs watched sent from the set top box to the head-end), and for distributing said contents with said digital information being embedded through a predetermined distribution mechanism (Column 11 lines 14-21 teaches digitally compressed signals which are the content signals and

other digital signals which are the polling signals are sent down element 216 in Figure 3; Element 216 is a predetermined distribution mechanism);

counting means for counting a distribution condition of contents per distribution mechanism based on said contents distributing history gathered through said information gathering means and said identification information held by said identification information holding means (Column 41 lines 62-67 and Column 42 lines 1-7 teaches correlating each program with a price and from the last polling cycle and then having the CPU generate a bill; for a bill to be generated the CPU would need to count up the number to programs from the account history file);

and fee calculating means for determining a charging amount per distribution mechanism based on said counted distribution condition and a charging rule for said contents (Column 42 lines 7-12 teaches assigning a charging amount or price to each program from last polling response and then generating a bill for each user based on the updated account history).

At the time of the invention it would have been obvious to a person of ordinary skill in the art, to modify the information gathering and processing function/device of Maruo using the embedded information and bill totaling device/function of Hendricks for the purpose of providing the set-top terminal 220 with billing information (Column 42 lines 15-16, Hendricks), so the user does not require a bill to be sent in the mail.

Maruo and Hendricks fail to teach identification information holding means for holding identification information for identifying said distributed contents and said distribution mechanism.

In an analogous art Hofmann teaches identification information holding means for holding identification information for identifying said distributed contents and said distribution mechanism (Column 8 lines 43-46 teaches storing in database element 424 in Figure 4A information of the service provider (second line from bottom in Figure 6) and the distributed contents (First 3 lines in Figure 6)).

At the time of the invention it would have been obvious to a person of ordinary skill in the art, to modify the combined systems of Maruo and Hendricks using the identification holding function/device of Hofmann for the purpose of being able to search or classify each of the fields in a record (Column 8 lines 35-36 Hofmann).

Referring to claim 9, Maruo teaches computer program for causing a computer system connectable to a network with which a user terminal is allowed to connect, to operate as a fee managing system for managing fees of contents in which the fees arise based on a predetermined charging rule upon distributing the contents, said user terminal executing information processing by utilizing the contents, said computer program causing said fee managing system to comprise:

information gathering means for gathering information from said network (Mauro teaches in Figure 4 element 450a a set-top box which is the same as a user terminal, Figure 5B teaches element 450 including a front-end block 510 and figure 6 teaches element 510 including element 560 a CPU which inherently requires a computer

program to operate; Column 4 lines 26-31 teaches transmitting data from the set top box cable modem to the broadcast system operator, the CPU controls the data flow to the cable modem);

but fails to teach distributing means for embedding to said contents, digital information causing said user terminal to transmit a contents distributing history to said information gathering means at a predetermined timing while said user terminal is connected with said network, and for distributing said contents with said digital information being embedded through a predetermined distribution mechanism; counting means for counting a distribution condition of contents per distribution mechanism based on said contents distributing history gathered through said information gathering means and said identification information held by said identification information holding means; and fee calculating means for determining a charging amount per distribution mechanism based on said counted distribution condition and a charging rule for said contents; identification information holding means for holding identification information for identifying said distributed contents and said distribution mechanism.

In an analogous art Hendricks teaches distributing means for embedding to said contents, digital information causing said user terminal to transmit a contents distributing history to said information gathering means at a predetermined timing while said user terminal is connected with said network, and for distributing said contents with said digital information being embedded through a predetermined distribution mechanism (Figure 6a teaches element 224 a CPU which requires a computer program

to operate in the Network Controller which sends out polling requests to the set top terminals over the cable television network, The abstract teaches the invention functions are accomplished using software),

counting means for counting a distribution condition of contents per distribution mechanism based on said contents distributing history gathered through said information gathering means and said identification information held by said identification information holding means (Column 41 lines 62-67 and Column 42 lines 1-7 teaches correlating each program with a price and from the last polling cycle and then having the CPU generate a bill; for a bill to be generated the CPU would need to count up the number to programs from the account history file); and

fee calculating means for determining a charging amount per distribution mechanism based on said counted distribution condition and a charging rule for said contents (Column 41 lines 62-67 and Column 42 lines 1-14 teaches CPUs operating which inherently need a computer program to operate), but is silent on identification holding means of the distribution mechanism.

At the time of the invention it would have been obvious to a person of ordinary skill in the art, to modify the computer program function/device of Maruo computer program function/device using the computer program function/device of Hendricks for the purpose of providing the set-top terminal 220 with billing information (Column 42 lines 15-16, Hendricks), so the user does not require a bill to be sent in the mail.

Maruo and Hendricks fail to teach identification information holding means for holding identification information for identifying said distributed contents and said distribution mechanism.

In an analogous art Hofmann teaches identification information holding means for holding identification information for identifying said distributed contents and said distribution mechanism (Column 8 lines 20-26 teach a data flow controller and a merged database which each would have to have a processor with computer code running on them to operate).

At the time of the invention it would have been obvious to a person of ordinary skill in the art, to modify the combined computer program functions of Maruo and Hendricks using the computer program functions of Hofmann for the purpose of being able to search or classify each of the fields in a record (Column 8 lines 35-36 Hofmann).

Referring to claim 10, depending on claim 9, see rejection of claim 9 with reference to physical objects in figures.

Claims 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maruo et al. (U.S. 6757909 B1) in view of Tsuria et al. (U.S. 6424947 B1) further in view of Hendricks et al. (U.S. 6738978 B1) still further in view of Russo (U.S. 5619247).

Referring to claim 7, Maruo teaches a system for managing fees of contents in which the fees arise based on a predetermined charging rule upon utilizing the contents, said system comprising (Column 4 lines 26-29 teaches the broadcast system receiving billing information from subscribers for contents such as pay per view movies or events):

issuing means for issuing a recording medium to a user operating a user terminal which carries out information processing by utilizing said contents (Column 8 lines 46-61 teaches the smart card having a key for descrambling broadcast signals from a system operator and the smart card being implemented by a user terminal element 450 in Figure 4; the smart card would have to be issued to the user or else no video could be watched),

information gathering means provided on a network with which said user terminal with said recording medium being loaded is allowed to connect (Column 8 lines 47-54 teaches a smart card or recording medium being used; Column 7 lines 25-32 teaches the set-top box sends out billing information to a MSO so a connection exists between the user terminal or set-top box and the MSO);

but fails to teach recording medium having a data recording area in which user identification data is recorded and a nonvolatile memory area, said user terminal to store a contents utilizing history indicating utilizing condition of the contents to said memory area, distributing means for embedding to said contents, digital information causing said user terminal to store a contents utilizing history indicating utilizing

condition of the contents to a memory area, and to read said stored contents utilizing history so as to transmit said contents utilizing history to said information gathering means along with said user identification data at a predetermined timing while said user terminal is connected with said network, and for distributing said contents with said digital information being embedded through a predetermined distribution mechanism, identification information holding means for holding identification information for identifying said distributed contents; counting means for counting a utilization condition of the contents per user based on the contents utilizing history and the user identification data gathered through said information gathering means and the identification information held by said identification information holding means; and fee calculating means for determining a charging amount per user based on said counted utilization condition and a charging rule for said contents.

In an analogous art Tsuria teaches said recording medium having a data recording area in which user identification data is recorded and a nonvolatile memory area (Column 6 lines 54-67 teaches the smart card, which is a recording medium, having personal identification number on it, and the card would have to have nonvolatile memory area on it because a smart card is a plastic card with no power source connected to it).

said user terminal to store a contents utilizing history indicating utilizing condition of the contents to said memory area, (Column 8 lines 49 – 56 teaches a smart card storing viewing habits which the examiner views as utilizing history; The examiner notes

that the smart card 64 is different than smart card 42 which holds the user identification data, but notes Column 12 lines 10-15 and Column 12 lines 21-28 teach transferring parental control restriction codes which is user identification data between the two smart or information cards; Since this data is transferred one smart card element 64 contains both the user history and user identification information).

At the time of the invention it would have been obvious to a person of ordinary skill in the art, to modify the information gathering and processing function/device of Maruo using the storing of habits and preferences and utilizing history in a smart card function function/device of Tsuria for the purpose of providing the information to a broadcaster of the television transmissions (Column 8 lines 63-64 Tsuria).

Maruo and Tsuria fail to teach distributing means for embedding to said contents, digital information causing said user terminal to store a contents utilizing history indicating utilizing condition of the contents to a memory area, and to read said stored contents utilizing history so as to transmit said contents utilizing history to said information gathering means along with said user identification data at a predetermined timing while said user terminal is connected with said network, and for distributing said contents with said digital information being embedded through a predetermined distribution mechanism, identification information holding means for holding identification information for identifying said distributed contents; counting means for counting a utilization condition of the contents per user based on the contents utilizing history and the user identification data gathered through said information gathering means and the identification information held by said identification information holding

means; and fee calculating means for determining a charging amount per user based on said counted utilization condition and a charging rule for said contents.

In an analogous art Hendricks teaches distributing means for embedding to said contents (Column 11 lines 14 - 19 teaches sending other digital signals to the set-top boxes over element 216 which also carries the pay- per-view movies and events in Figure 3, so the data is embedded together; Column 19 lines 26-31 teaches program control information or digital information being sent to the set top box) digital information causing said user terminal to store a contents utilizing history indicating utilizing condition of the contents to a memory area (Column 44 lines 55-58 teaches supporting movies on demand, Column 21 lines 22-25 teaches the program control information containing pricing information so the set top box would know from the price information to store the data if the program with a price is utilized; Column 27 lines 50-54 teaches storing program access information which is the same as utilization history), and to read said stored contents utilizing history so as to transmit said contents utilizing history to said information gathering means along with said user identification data at a predetermined timing while said user terminal is connected with said network (Column 28 lines 18-27 teaches the set-top box returning digital information because of a polling request which is program control information, so the data has to be read from memory; Column 11 lines 61-62 teaches a predetermined time of daily, weekly, or monthly; Column 29 lines 6 - 39 teaches the list of programs watched sent from the set top box to the head-end),

and for distributing said contents with said digital information being embedded through a predetermined distribution mechanism (Column 11 lines 14-21 teaches digitally compressed signals which are the content signals and other digital signals which are the polling signals are sent down element 216 in Figure 3; Element 216 is a predetermined distribution mechanism),

identification information holding means for holding identification information for identifying said distributed contents (Column 42 lines 5-6 teaches the head end having a Price Category File in the Program Library database); but fails to teach the rest of the limitations of claim 7.

At the time of the invention it would have been obvious to a person of ordinary skill in the art, to modify the combined systems of Maruo and Tsuria using the embedded information and the information gathering and processing device/function of Hendricks for the purpose of providing the set-top terminal 220 with billing information (Column 42 lines 15-16, Hendricks), so the user does not require a bill to be sent in the mail.

Maruo, Tsuria, and Hendricks fail to teach counting means for counting a utilization condition of the contents per user based on the contents utilizing history and the user identification data gathered through said information gathering means and the identification information held by said identification information holding means; and fee calculating means for determining a charging amount per user based on said counted utilization condition and a charging rule for said contents.

In an analogous art Russo teaches counting means for counting a utilization condition of the contents per user based on the contents utilizing history and the user identification data gathered through said information gathering means and the identification information held by said identification information holding means (Column 5 lines 41-47 teaches counting the number of times the user utilizes the program if they store the program for an extend period of time, Column 10 lines 22-30 teaches the program provider being informed that a program has been viewed, and Column 9 lines 12-16 teaches a telephone line being used to communicate to the program provider billing and account transactions so identification information related to the user would have to be sent with the utilizing history or the program provider would not know who to bill, Column 67 lines 26-27 teaches a two way communication system between the user's system and the program provider);

and fee calculating means for determining a charging amount per user based on said counted utilization condition and a charging rule for said contents (Column 5 lines 41-47 teaches counting the number of times the user utilize the program if they store the program for an extend period of time and use view the program over an extend period of time).

At the time of the invention it would have been obvious to a person of ordinary skill in the art, to modify the combined systems of Maruo, Tsuria, and Hendricks, using the utilization history and fee calculating function/device of Russo for the purpose of having the user only responsible for payment only after a particular selection has been viewed or enjoyed (Column 1lines 7-9, Russo).

Referring to claim 8, Maruo teaches a system for managing fees of contents according to claim 7, but fails to teach wherein said recording medium is a card equipped with an IC chip, said card being individualized per user, and information indispensable for utilizing said contents is recorded in said card.

In an analogous art Tsuria teaches wherein said recording medium is a card equipped with an IC chip (Column 1 lines 46-54 teaches an IC card), said card being individualized per user (Column 7 lines 62-67 teaches a personal identification number stored on the card to the card has to be individualized to a user), and information indispensable for utilizing said contents is recorded in said card (Column 6 lines 54-61 teaches the smart card storing authorization keys to decode the television transmission so the user can watch programming).

At the time of the invention it would have been obvious to a person of ordinary skill in the art, to modify the information gathering and processing function/device of Maruo using the IC card function/device of Tsuria for the purpose of providing television systems having portable devices for receiving program transmissions and or authorizations (Column 2 lines 20-22 Tsuria)

Claims 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maruo et al. (U.S. 6757909 B1) in view of Hendricks et al. (U.S. 6738978 B1) further in view of Russo (U.S. 5619247).

Referring to claim 11, Maruo teaches a computer program for causing a computer system connectable to a network with which a user terminal is allowed to connect, to operate as a fee managing system for managing fees of contents, said user terminal loaded with a recording medium having a data recording area for recording user identification data for identifying a user operating said user terminal and a nonvolatile memory area so as to execute information processing by utilizing the contents, said computer program causing said fee managing system to comprise:

information gathering means for gathering information from said network (Mauro teaches in Figure 4 element 450a a set-top box which is the same as a user terminal, Figure 5B teaches element 450 including a front-end block 510 and figure 6 teaches element 510 including element 560 a CPU which inherently requires a computer program to operate; Column 4 lines 26-31 teaches transmitting data from the set top box cable modem to the broadcast system operator, the CPU controls the data flow to the cable modem);

but fails to teach distributing means for embedding to said contents, digital information causing said user terminal to store a contents utilizing history indicating utilizing condition of the contents to said memory area, and to read said stored contents utilizing history so as to transmit said contents utilizing history to said information

gathering means along with said user identification data at a predetermined timing while said user terminal is connected with said network, and for distributing said contents with said digital information being embedded through a predetermined distribution mechanism; identification information holding means for holding identification information for identifying said distributed contents; counting means for counting a utilization condition of the contents per user based on the contents utilizing history and the user identification data gathered through said information gathering means and the identification information held by said identification information holding means; and fee calculating means for determining a charging amount per user based on said counted utilization condition and a charging rule for said contents

In an analogous art Hendricks teaches distributing means for embedding to said contents, digital information causing said user terminal to store a contents utilizing history indicating utilizing condition of the contents to said memory area, and to read said stored contents utilizing history so as to transmit said contents utilizing history to said information gathering means along with said user identification data at a predetermined timing while said user terminal is connected with said network, and for distributing said contents with said digital information being embedded through a predetermined distribution mechanism (Figure 6a teaches element 224 a CPU which requires a computer program to operate, in the Network Controller which sends out polling requests to the set top terminals over the cable television network; The abstract teaches the invention functions are accomplished using software);

identification information holding means for holding identification information for identifying said distributed contents (Column 42 lines 5-6 teaches the head end having a Price Category File in the Program Library database and a database is a computer which runs programs).

At the time of the invention it would have been obvious to a person of ordinary skill in the art, to modify the computer program function/device of Maruo using the computer program function/device of Hendricks for the purpose of providing the set-top terminal 220 with billing information (Column 42 lines 15-16, Hendricks), so the user does not require a bill to be sent in the mail.

Maruo and Hendricks fail to teach counting means for counting a utilization condition of the contents per user based on the contents utilizing history and the user identification data gathered through said information gathering means and the identification information held by said identification information holding means; and fee calculating means for determining a charging amount per user based on said counted utilization condition and a charging rule for said contents.

In an analogous art Russo teaches counting means for counting a utilization condition of the contents per user based on the contents utilizing history and the user identification data gathered through said information gathering means and the identification information held by said identification information holding means (Column 2 lines 15-32 teaches a billing computer which would obviously run a program to determine what program was watched, combining this billing computer with the later

Art Unit: 2623

memory querying of Column 10 line 26 creates a computer program that looks at the utilization history of a user); and fee calculating means for determining a charging amount per user based on said counted utilization condition and a charging rule for said contents (Column 6 lines 26-27 teaches a two way system what would have to run a program in order to instruct components of the system to sense the use and debit an account, the system has to have a charging rule or it would not know how much to debit from the account).

At the time of the invention it would have been obvious to a person of ordinary skill in the art, to modify the combined computer programs of Maruo and Hendricks using the computer program functions of Russo for the purpose of having the user only responsible for payment only after a particular selection has been viewed or enjoyed (Column 1 lines 7-9, Russo).

Referring to claim 12, depending on claim 11, see rejection of claim 11 which references physical objects to embody the computer code.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter C. Wilder whose telephone number is 571-272-2826. The examiner can normally be reached on 8 AM - 4PM Monday - Friday.

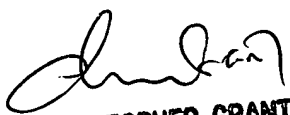
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Grant can be reached on (571) 272-7294. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Application/Control Number: 09/942,978
Art Unit: 2623

Page 37

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